

REMARKS

Reconsideration of the present application is respectfully requested. Claim 1 has been amended. Claims 1 – 35 are currently pending.

Rejections based on 35 U.S.C. § 102

Claims 1 – 35 stand rejected under 35 U.S.C. §102(a) as being anticipated by “Simplifying the Management of Large Photo Collections” by Girgensohn, *et al.* (“Girgensohn”). This rejection is respectfully traversed on two independent grounds. First, Applicants have resubmitted a Declaration and written evidence demonstrating that Applicants conceived of the present invention and reduced it to practice before the effective date of the Girgensohn reference. Second, Applicants have amended independent claim 1 to further distinguish their claimed invention from the prior art.

Declaration under 37 C.F.R. § 1.131

The Girgensohn reference does not qualify as prior art. Indeed, a product embodying Applicants’ claimed invention, Microsoft® Digital Image Suite 9, was already on the market at the time of Girgensohn’s publication. While the present application was filed on January 23, 2004, Applicants actually reduced their invention to practice on or before July 29, 2003 with the release date of Microsoft® Digital Image Suite 9. Girgensohn relies on a publication date of September 1, 2003. *See* Notice of References Cited. Considering the submitted evidence, it cannot be reasonably disputed that Applicants conceived of and actually reduced their invention to practice before the publication date of the Girgensohn reference. As such Girgensohn reference does not qualify as prior art.

In response to the previous non-final and final Office Actions, Applicants submitted a Declaration under 37 C.F.R. § 1.131, along with Exhibits A and B, to overcome the present rejection. This Declaration, along with Exhibits A and B, are resubmitted for a third time herewith. In the Declaration, Applicants swear behind the effective date of the Girgensohn reference and attest that the date of conception of the present invention was at least before the publication date of the Girgensohn reference. Together, Exhibits A and B provide written evidence to support such a date of conception.

The Final Office Action indicates the Declaration is ineffective to overcome the Girensohn reference because “there is no proof of due diligence between the span of 10/31/2003 through the effective filing date of 1/23/2004.” Respectfully, the Final Office Action misapplies the relevant legal standard. Section 1.131 of Title 37 of the Code of Federal Regulations allows Applicants to remove a reference by presenting evidence demonstrating a “reduction to practice prior to the effective date of the reference . . .” 37 CFR 1.131 (emphasis added). Pursuant to § 1.131, the Applicants are not required to provide evidence of due diligence from 10/31/2003 to 1/23/2004 because Applicants actually reduced their invention to practice before September 1, 2003, the effective date of the Girgensohn reference. Because Applicants have submitted evidence of a “reduction to practice prior to the effective date of” the Girgensohn reference, Applicants are not required to also prove diligence until their filing date. See 37 CFR 1.131.

To prove the date that Applicants actually reduced their invention to practice, Applicants have provided Exhibit A. Exhibit A is a press release announcing the release of a software product titled “Microsoft® Digital Image Suite 9” on July 29, 2003. Microsoft® Digital Image Suite 9 embodies the claimed invention (as demonstrated by Exhibit B), and, thus,

the release of this product on July 29, 2003 is evidence that Applicants actually reduced their invention to practice prior to the effective date of the Girgensohn reference.

To prove that Microsoft® Digital Image Suite 9 embodies the claimed invention, Applicants have provided Exhibit B, which includes a series of screen shots generated by Microsoft® Digital Image Suite 9. These screen shots prove that the Digital Image Suite 9 product, released on July 29, 2003, is an actual reduction to practice of the claimed invention. A mapping of claim 1 to the content of Exhibit B is provided as an example:

<p>Claim 1: A computer-implemented method for presenting a set of items to a user, the method comprising:</p> <ul style="list-style-type: none">dividing said set of items into one or more groups according to a selected characteristic;automatically generating one or more group titles for at least a portion of said one or more of groups, wherein said one or more group titles indicate at least one characteristic shared by the items in one of said one or more groups;presenting at least a portion of said set of items in accordance with said groups to the user on a display;

Pages 1 and 2 of Exhibit B illustrate the presentation of items (i.e., photographs) in groups, as dictated by a selected characteristic. For example, in the top screen shot on page 1 the photos are divided into a December 2003 group and a September 2003 group. The various screen shots of Exhibit B also illustrate the generation and display of group titles indicating shared group characteristics. For example, on the top screen shot of page 3, the group titles indicate a period of time when the photos were taken, whereas the group titles on the lower screen shot of page 3 indicate the sub-folders associated with the groupings. On the lower screen shot of page 4, the group titles indicate the keywords shared by the grouped items.

<p>presenting a listing of said one or more group titles on said display; and indicating on said display which of said groups contain one or more items currently visible to the user.</p>
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The center, vertical column of the screen shots displayed on pages 1 and 2 provides a listing of the groups used to divide the photos. In addition, a horizontal, gray bar

indicates the groups currently visible to the user in the right-most pane. For instance, the gray bar in the first screen shot on page 1 indicates the images from December 2003 and September 2003 are presently being displayed to the user. Because the Microsoft® Digital Image Suite 9 product includes each and every claimed aspect of the present invention, it is an actual reduction to practice that pre-dates the effective date of the Girgensohn reference.

Applicants further note that FIGS. 2A-C and FIGS. 5A-C of the present application also indicate their creation by Microsoft® Digital Image Suite 9. As such, the specification of the present application, in discussing FIGS. 2A-C and FIGS. 5A-C, provide further evidence of the mapping of the claimed invention to the interface provided by Microsoft® Digital Image Suite 9.

In sum, the Declaration and written evidence (along with FIGS. 2A-C and FIGS. 5A-C) demonstrate that Applicants conceived of the present invention and reduced it to practice before the effective date of the Girgensohn reference. As such, the Office Action can no longer maintain a valid rejection under 35 U.S.C. § 102(a) as the Girgensohn reference does not qualify as prior art. Accordingly, withdrawal of the rejection of claims 1 - 35 under 35 U.S.C. § 102(a) is respectfully requested. In the event the Examiner has any additional issues as regarding the Declaration, Applicants respectfully request the Examiner contact the undersigned by telephone or email so as to the facilitate the prosecution of this application.

Amended Independent Claim 1

To further advance prosecution of the application, Applicants have also amended independent claim 1. Claim 1, as amended, now recites “automatically generating one or more group titles for at least a portion of said one or more of groups, wherein said one or more group titles indicate at least one characteristic shared by the items in one of said one or more groups.”

Applicants respectfully submit that Girgensohn fails to teach this limitation of amended independent claim 1.

On the topic of generating group titles, Girgensohn merely states that “generated names are added for photos that do not belong to any of the existing events.” Girgensohn, page 5, col. 2, para. 3. This discussion, of course, does not teach the claimed automatic generation of group titles and provides no discussion regarding how Girgensohn creates its “generated names.” Thus, Girgensohn cannot anticipate claim 1. Indeed, anticipation requires enablement, whereby the reference “must teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation.” See *Elan Pharmaceuticals, Inc. v. Mayo Foundation*, 346 F.3d 1051, 1054-55 (Fed. Cir. 2003); *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339 (Fed. Cir. 2000) (a prior art reference that does not enable a person of ordinary skill in the art to practice the claimed invention does not anticipate the patent claims); *Akzo N.V. v. United States Int’l Trade Comm’n*, 808 F.2d 1471, 1480 (Fed. Cir. 1986) (anticipation requires that the reference publicly discloses all elements of the claimed invention and enables its practice); *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 665 (Fed. Cir. 1986) (a non-enabling publication is insufficient to anticipate under 102). Girgensohn’s disclosure as to generating group titles is clearly insufficient to enable or anticipate claim 1, and Applicants respectfully submit that independent claim 1 is in condition for allowance. Applicants further submit that dependent claims 2 - 14, which depend from claim 1, are in condition for allowance for at least the same reasons discussed above with respect to claim 1.

Conclusion

For the reasons stated above, claims 1 – 35 are in condition for allowance. If any issues remain which would prevent issuance of this application, the Examiner is urged to contact the undersigned prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112.

Respectfully submitted,

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